



PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: A7705

H. Darrel DARBY

Appln. No.: 10/019,669

Group Art Unit: 3728

Confirmation No.: 6168

Examiner: Marie D. PATTERSON

Filed: May 13, 2002

For: HEALING SHOE OR SANDAL

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated August 26, 2005. Entry of this Reply Brief is respectfully requested.

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STATUS OF CLAIMS

Claims 1-42 are all of the pending claims. Dependent method claims 33 and 34 remain withdrawn from consideration. Claims 3, 6, 9, 12-30, and 35-40 are allowed.

Claims 1, 2, 4, 5, 7, 8, 10, 11, 31, 32, 41 and 42 stand rejected. All rejected claims are appealed. The rejected claims were set forth in the Appendix submitted with Appellant's Brief on Appeal filed August 3, 2005.

REPLY BRIEF UNDER 37 C.F.R. § 41.41
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GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 2, 4, 5, 7, 8, 10, 11, 31, 41 and 42 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Darby (U.S. Patent No. 5,491,909, hereinafter “Darby ‘909”) in view of Darby et al. (U.S. Patent No. 5,370,133, hereinafter “Darby ‘133”), and further in view of Grim et al. (U.S. Patent No. 5,329,705, hereinafter “Grim”).

Claim 32 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Darby ‘909 in view of Darby ‘133 and Grim, and further in view of Kellerman et al. (U.S. Patent No. 5,799,414).

ARGUMENT

For the reasons set forth in Appellant's Brief on Appeal, the rejection of the claims on appeal should be reversed. In addition, Appellant submits the following remarks addressing certain points raised by the Examiner in her Answer.

As noted in Appellant's Brief on Appeal, Appellant submits that the rejection of claim 1 is improper because the Examiner has failed to establish *prima facie* obviousness. For instance, as evidenced by the Examiner's Answer, the Examiner continues to mischaracterize the actual teaching of Darby '133, which is relied upon by the Examiner as allegedly teaching the claimed circumferential counter portion that the Examiner concedes as being deficient in Darby '909. As pointed out by Appellant,

“...the Examiner refers only to element 16A in Figure 1 of Darby '133.¹ As taught by Darby '133, lip 18A is a 'semi-circular vertical wall portion' which is provided in 'the open toe area 80' and rises above the upper surface of insole 24. *See* Darby '133 at col. 5, lines 1-8. However, as clearly shown in Figure and described by Darby '133, the wall portion of lip 18A is only provided at the open toe area. Thus, the combination of Darby '909 and Darby '133 would at most teach a semi-circular vertical wall provided at the open toe area.”

See Appellant's Brief on Appeal at pages 11-12.

In response, the Examiner alleges, “the lip of Darby '133 shown as 16A is clearly around the entire periphery of the shoe as shown in figures 1 and 6 in that the lip is continuous and

¹ Appellant notes that element 16A of Figure 1 is apparently referred to as “lip 18A” in the description of Figure 1, as element 16A does not appear to be mentioned in the detailed description of Darby '133.

formed integral with the heel portion numbered 34 which is clearly above all sole layers.” *See* Examiner’s Answer at page 5. However, as noted above, element 16A is not recited in the description of Darby ‘133. Rather, it is apparent from review of the disclosure of Darby ‘133 that element 16A in Figure 1 corresponds to “semi-circular vertical wall portion or lip 18A”. *See* Darby ‘133 at col. 5, lines 1-9. Thus, element 16A is nothing more than a semi-circular vertical wall portion “to protect exposed toes of the user.” *See* Darby ‘133 at col. 5, lines 6-9.

Further, the Examiner asserts that “the lip is continuous and formed integral with the heel portion numbered 34 which is clearly above the sole layers.” However, the Examiner has not previously relied upon both element 16A, which, as discussed above, is merely a vertical wall portion at the toe region, and rounded heel counter 34 of Darby ‘133. *See* Final Office Action dated March 7, 2005 at page 2. Rather, the grounds of rejection merely allege that it would have been obvious to include element 16A. There is no mention in the grounds of rejection of modifying the shoe of Darby ‘909 with rounded heel counter 34 or any other element of Darby ‘133 other than the semi-circular vertical wall portion disclosed by element 16A. Thus, Appellant again submits that the semi-circular wall portion of Darby ‘133 cannot properly be relied upon to teach the circumferential counter which extends “upward circumferentially from the top surface of the base portion of the out sole around the base portion of the out sole thereby providing a cavity in the out sole”, as claimed.

Next, the Examiner continues to allege that the layers of Grim, which the Examiner combines with Darby '133 and Darby '909, would be prevented from shifting if rearranged in an order which was clearly not intended by their design. To wit, the Examiner states,

“...the layer 66 has hook and loop fastening means which are clearly capable of being attached to the hook and loop fastening elements at 54 on element 20 and the bladder layer 64 could be placed above layer 66 loosely. Also, since the rim/lip of Darby '133 clearly extends up over the sides and heel portions of the foot (see highlighted portion in the attached marked up copy of figure 1 of Darby '133) and therefore inherently and clearly would be high enough to prevent shifting of the layers.”

...

“In response to Applicant’s arguments directed towards a stacking order with the layer 20 of Grim being located above all other layers, there is no requirement of such an order in the claims, the claims merely require that the layers are capable of being stacked in different layers. Merely reversing the order of the two top layers (52 and 54) meets this claim limitation.

...

There is no requirement in the claims for the layers to be rearranged, only that they are “capable of being rearranged” and the layers of Grim have that capability.”

See Examiner’s Answer at pages 5-6.

However, the Examiner’ characterization of the claims merely requiring the plurality of insole layers as having the capability of being rearranged is inaccurate and misleading. Rather, claim 1 requires the “plurality of insole layers are capable of being rearranged so as to be stacked in different orders” and “the out sole circumferential counter prevents each of the plurality of insole layers from shifting within the out sole cavity when the insole layers are stacked in each of the different orders.” Thus, it is not merely the capability of the layers of being stacked in different orders, but also the prevention of shifting of each of the plurality of insole layers within

the outsole cavity when the layers are stacked in each of the different orders. Further, the grounds of rejection fail to establish that the layers identified by the Examiner would in any way be prevented from shifted when stacked in a different manner than actually disclosed by Grim.

For example, the Examiner presently suggests that the individual resilient sections 68 of Grim, which comprise the upper resilient layer 66, could be removed from the inner sole assembly 52 and attached directly to the soft goods type support member 20, and then the inner sole assembly, which includes lower air bladder 64, could be placed on top of the layer of individual resilient sections 68. Thus, despite this arrangement being clearly in contradiction with the intended ordering of upper resilient layer, lower air bladder, soft goods type support member that is actually taught by Grim, the Examiner contends that the rearranged layers would be prevented from shifting.

Appellant respectfully disagrees. Initially, the Examiner apparently assumes the height of element 16A of Darby '133 would be "high enough to prevent shifting of layers." The grounds of rejection fail to demonstrate that the vertical wall portion of Darby '133 is of sufficient height to prevent shifting of the layers of Grim when rearranged in the manner suggested. Rather, the Examiner appears to assume the height is sufficient by alleging that the lip "inherently and clearly would be high enough to prevent shifting of the layers". However, the Examiner has not provided any evidence of the relative heights of the layers of Grim compared to the semi-circular vertical wall portion of Darby '909 sufficient to establish that the semi-

circular wall portion would prevent shifting of the layers of Grim if rearranged in the manner suggested.

Moreover, Appellant notes that claim requires that the circumferential counter prevents each of the plurality of insole layers from shifting within the outsole cavity when stacked in each of the different orders. However, there is no showing that the layers of Grim would be prevented from shifting within the outsole cavity by the semi-circular vertical wall portion of Darby '133 if the layers are reordered such that the individual resilient sections 68 of upper resilient layer 66 attach directly to the support member 20, and inner sole assembly 52 is arranged on top of the individual resilient sections.

Indeed, in the configuration suggested by the Examiner, the securing material 54 on the bottom of inner sole assembly 52 would be resting directly on the individual resilient sections 68 and would therefore not prevent the inner sole assembly 52 from shifting. Indeed, Grim clearly teaches that securing material 54 is intended to secure the inner sole assembly 52 to the support member 20. *See* Grim at col. 4, lines 9-21. There is no suggestion that a semi-circular wall portion, as taught by Darby '133, would prevent shifting within the outsole cavity if the layers of Grim are rearranged in the manner alleged by the Examiner. Thus, at least for the reasons discussed above and in Appellant's Brief on Appeal, the combination of Darby '909, Darby '133 and Grim cannot reasonably be interpreted to teach all the claim limitations.

Turning to this issue of the deficient motivation to combine Darby '909, Darby '133 and Grim, Appellant again submits that the Examiner's grounds of rejection do not meet the Federal

Circuit's *rigorous* standard for demonstrating that the claimed subject matter would have been obvious in view of the applied art. For instance, the Examiner states:

“In this case, Darby ‘705 and ‘133 and Grim are all directed towards medical boots. Darby ‘133 clearly teaches the use of a lip/circumferential counter (shown in the highlighted figure) for increase [sic] support and stability as discussed in column 5. Grim clearly teaches many benefits and provides clear motivation for using insole layers including a bladder and a layer with removable sections for medical reasons as recited in column 1 lines 15-42 and column 2 lines 11-23.”²

See Examiner's Answer at pages 6-7.

In the Final Office Action, however, the Examiner stated the following:

“It would have been obvious to provide the outsole with a counter portion as taught by Darby ‘133 and to provide an insole having a plurality of different separable layers as taught by Grim in the shoe of Darby ‘909 to provide greater stability to the outsole/upper construction and to increase the cushioning and medial benefits of the insole construction taught by Grim.”

See Final Office Action of March 7, 2005 at page 3.

Notwithstanding the Examiner's expanding on of the alleged motivations to combine these references, the Examiner has failed to establish that the combination of Darby ‘909, Darby ‘133, and Grim would have been obvious. As previously discussed, there is no showing that a semi-circular vertical wall portion, or lip, as taught by Darby ‘133 would provide the benefit of increasing support and stability to the medical shoe of Darby ‘909. *See* Appellant's Brief of Appeal at page 17. Indeed, Darby ‘909 merely teaches that the semi-circular wall portion

² Appellant notes that there is no “Darby ‘705” of record in the present Application. Thus, Appellant believes the Examiner intended to refer to Darby ‘909.

identified by the Examiner “protects the exposed toes of the user.” *See* Darby ‘133 at col. 5, lines 1-5 and discussion *infra*. Similarly, there is no showing that one of ordinary skill would have been motivated to further modify the combination Darby ‘909 and Darby ‘133 with the teachings of Grim, wherein the Examiner contends that the layers of Grim would be rearranged in clear contradiction to their intended arrangement. *See* Appellant’s Brief on Appeal at page 18.

Appellant again submits that the alleged motivation provided by the Examiner strongly suggests that the Examiner has relied upon *improper hindsight construction*, using Appellant’s disclosure, *not the objective teachings of the prior art*, as a template for picking and choosing various features from multiple references to address the limitations of the claims. Thus, the motivation asserted by the Examiner clearly is not consistent with a “rigorous application of the requirement for a showing of the teaching or motivation to combine” and the Examiner has failed to establish *prima facie* obviousness.

Accordingly, Appellant respectfully submits that the rejection of dependent claim 1 is improper. As noted, Appellant submits that claim 31 should be allowable at least for the same reasons as claim 1, and claims 2, 4, 5, 6, 8, 10, 11 and 32 are believed to be allowable at least by virtue of depending from claims 1 and 31 respectively.

Regarding claims 41 and 42, which respectively depend from independent claims 1 and 31 and require that “said plurality of separably removable layers include at least three layers”, Appellant disagrees with the Examiner’s characterization that claims 41 and 42 stand or fall together with claims 1, 2, 4, 5, 7, 8, 10, 11, 31 and 32. *See* Examiner’s Answer at page 2.

Appellant has clearly demonstrated why claims 41 and 42 are believed to be separably patentable. Indeed, in a separate section of Appellant's arguments, Appellant argued,

“...the combination of Darby '909, Darby '133, and Grimm cannot properly be relied upon to teach at least *three separably removable* layers, wherein the out sole circumferential counter prevents each of the plurality of layers from shifting within the out sole cavity when the layers are stacked in each of different orders.

As noted above, the Examiner identifies the inner sole assembly 52, lower air bladder 64, and resilient inner sole 66³ as corresponding to the recited three separably removable insole layers. However, the layers of Grimm's inner sole assembly 52 are not *separably removable* so that the out sole circumferential counter prevents each of the plurality of layers from shifting within the out sole cavity when the layers are stacked in each of the different orders.

That is, the individual removable areas 68 of Grimm's upper resilient area 66 (See Grimm at Fig. 2) cannot correspond by themselves to one of the recited plurality of separably removable insole layers. If the removable areas 68 were removed from the inner sole assembly 52, the circumferential counter would not prevent the removable areas from shifting within the out sole cavity when the insole layers are stacked in each of the different orders. In fact, even if all of the removable areas 68 were removed together from the inner sole assembly 52 in an attempt to provide a separably removable layer, a circumferential counter would not prevent the removable areas 68 from shifting within the out sole cavity *if the removable areas 68 were the bottom of three layers*. Indeed, separated removable areas 68, which would necessarily not be secured to the upper surface of air bladder 64, as intended, would clearly shift within the shoe even if lip 18A of Darby '133 were present. Thus, at least for this reason, claims 41 and 42 should be allowed in addition to being allowable by virtue of depending from claims 1 and 31.”

³ See Office Action dated March 7, 2005 at page 2, and Grimm at Figs. 2 & 3.

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See Appellant's Brief on Appeal at pages 20-21 (Section VII(1)(c)).

However, the Examiner's Answer does not address the failure of the combination of Darby '909, Darby '133 and Grim to teach all the features of the medical shoe and assembly of a healing shoe defined by claims 41 and 42, respectively. As Appellant has clearly provided arguments in support of separate patentability in the Brief on Appeal, the Examiner cannot simply ignore these arguments and must provide notification that a statement regarding the claims not standing or falling together is not considered sufficient. See MPEP § 1206; *see also* Ex parte Schier, 21 USPQ2d 1016 (Bd. Pat. App. & Int. 1991); Ex parte Ohsumi, 21 USPQ2d 1020 (Bd. Pat. App. & Int. 1991). As Appellant has not been notified of any alleged non-compliance by the Examiner, the failure of the Examiner to address the recited features of the "plurality of separably removable layers including at least three layers" and Appellant's arguments in support of separate patentability of claims 41 and 42 is improper. Appellant again submits that claims 41 and 42 are believed to be allowable and that the rejection of these claims is improper for the reasons discussed in Appellant's Brief on Appeal.

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CONCLUSION

For the above reasons as well as the reasons set forth in Appellant's Brief on Appeal,
Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on
Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,



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